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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,205	10/08/2003	Satoru Adachi	9683/261	7459

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

PATEL, JAYESH A

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/680,205

Applicant(s)

ADACHI ET AL.

Examiner

Jayesh A. Patel

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 6-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3, 4, 5 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 6-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1105,09/05,03/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election without traverse of Claims 2,6,7,8 and 10 in the reply filed on December 11 2006 is acknowledged. Claims 1,3,4,5 and 9 are cancelled from further prosecution.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 10 defines [an image decoding program] embodying a functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines annex IV). That is, the scope of the presently claimed [An image decoding program] can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The Claim recites a functional descriptive material not on a computer readable medium. The specifications at page 13 ["An image decoding program" according to the present invention is configured to let a computer execute each of the above steps] shows

that the program is not on a computer readable medium and hence non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2,6,7,8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (US 5107345) hereafter Lee.

1. Regarding Claim 2, Lee discloses an image decoding method (**Fig 6**) of decoding encoded data in encoded by an image encoding method of dividing image signals into blocks, performing an orthogonal transform of each block, reading resultant orthogonal transform coefficients to obtain a coefficient string, and performing entropy coding thereof, the image decoding method comprising: a block selecting step of selecting a size of a block for the orthogonal transform, out of a plurality of blocks of different sizes at (**Col 2 Lines 35-57**); a decoding step for performing decoding of the encoded data by entropy coding (**Col 5 Lines 16 –17 and Col 6 Lines 10-13**) adapted to a coefficient string in a block of a minimum size (**2 x 2**) out of the plurality of blocks (**16 X 16, 8 X 8, 4 X 4 and 2 X 2**) at (**Col 7 Lines 32-52**); and a coefficient string constructing step of (**Fig 6**

elements 116a-116d), when a block of a size **(16 X 16, 116a Fig 6)** larger than the minimum size **(2 X 2, 116d Fig 6)** is selected in the block selecting step, constructing a coefficient string of the block of the larger size **(16 X 16 Col 15 Lines 46-50)** from a plurality of coefficient strings decoded in the decoding step at **(element 118 Fig 6)** and also at **(Col 15 Lines 37-51)**.

2. Regarding Claim 6, Lee discloses an image decoding apparatus at **(Col 2 Lines 18-21)** of decoding encoded data encoded by an image encoding method of dividing image signals into blocks, performing an orthogonal transform of each block, reading resultant orthogonal transform coefficients to obtain a coefficient string, and performing entropy coding thereof, the image decoding apparatus comprising: block selecting means **(element 102 in Fig 6)** for selecting a size of a block for the orthogonal transform, out of a plurality of blocks of different sizes; decoding means **(elements 104, 106 and 108 of Fig 6)** for performing decoding of the encoded data by entropy coding **(Col 5 Lines 16 –17 and Col 6 Lines 10-13)** adapted to a coefficient string in a block of a minimum size **(2 x 2)** out of the plurality of blocks **(16 X 16, 8 X 8, 4 X 4 and 2 X 2)** at **(Col 7 Lines 32-52)** ; and coefficient string constructing means **(element 118 Fig 6)** and also at **(Col 15 Lines 37-51)** for, when a block of a size larger **(16 X 16, 116a Fig 6)** than the minimum size **(2 X 2, 116d Fig 6)** is selected by the block selecting means at **(Col 2 Lines 50-58)** and **(element 102 fig 6)**, constructing a coefficient string of the block of the larger size **(16 X 16 Col 15 Lines 46-50)** from a plurality of

coefficient strings decoded by the decoding means at **(element 118 Fig 6)** and also at **(Col 15 Lines 37-51)**.

3. Regarding Claim 7, Lee discloses an image decoding apparatus according to claim 6, wherein the coefficient string constructing means is configured to read coefficients in the plurality of coefficient strings decoded by the decoding means, from the lowest in a low frequency region at **(elements 110 and 112 of Fig 6)** and write the coefficients read out of the respective coefficient strings at **(Col 14 Lines 34-46 and Col 4 Lines 52-57)**, one by one in order into a new coefficient string from the low frequency region at **(Col 13 Lines 57-63)**, thereby obtaining the constructed coefficient string at **(element 118 Fig 6)**.

4. Regarding Claim 8 see the explanation of Claim 7.

5. Regarding Claim 10, Lee discloses a System for decoding in Fig 6, which performs the method (program) of claim 2. Therefore see the corresponding explanation of Claim 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayesh A. Patel whose telephone number is 571-270-1227. The examiner can normally be reached on M-F 7.00am to 4.30 pm (5-

4-9). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jayesh Patel
1/30/07

JP

JINGGE WU
SUPERVISORY PATENT EXAMINER